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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
CREPEAU, JONATHAN	
ART UNIT	PAPER NUMBER
1746	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/917,630	SUDA, SEIJIRAU
	Examiner	Art Unit
	Jonathan S. Crepeau	1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action addresses claims 1-14. The claims remain rejected for the reasons of record herein. Accordingly, this action is made final.

Claim Rejections - 35 USC § 103

2. Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (U.S. Patent 5,599,640) in view of Sawa et al (U.S. Patent 6,030,724).

Regarding claim 1, Lee et al. is directed to an alkaline fuel cell comprising a negative electrode, a positive electrode, and an electrolyte solution (see abstract). Regarding claims 1 and 5, the electrolyte solution comprises KOH or NaOH at a pH greater than 7. Regarding claim 6, this range of pH is anticipatory of the claimed range of alkali metal hydroxide in solution (5-30 wt%) because solutions having a pH between 7 and 14 contain weight percentages of alkali metal hydroxide which encompass the claimed range. Regarding claims 1, 3, and 4, the electrolyte further comprises a metal-hydrogen complex capable of generating hydrogen ions, such as potassium borohydride, sodium borohydride or lithium aluminohydride (see abstract). Regarding claim 7, the amount of metal-hydrogen complex in the electrolyte solution is 0.01-50 wt% (see col. 4, line 13). Regarding claims 1 and 8, an oxygen source such as air or pure oxygen is connected to the cathode (see col. 5, line 57). Regarding claims 1 and 10, a separator (permeable membrane) functioning as an ion conductor is present between the electrodes (see

col. 4, lines 45-48). Regarding claim 10, the disclosure of an "ion conductor" is considered to be anticipatory of a cation exchange membrane and an anion exchange membrane. Regarding claim 1, the negative electrode contains a hydrogen storage alloy (see col. 4, lines 34-44). Regarding claim 2, the alloy may have a composition of $Zr_{1-x}Ti_xCr_{1-Y-Z-A-B}Mn_YFe_ZCo_AV_BNi$ (see column 4, line 40). This formula reduces to $Zr_{0.6}Ti_{0.4}Cr_{0.5}Mn_{0.5}Ni$ when X=0.4, Y=0.5, Z=0, A=0, and B=0.

Lee et al. do not expressly teach the same alloy subscripts as recited in claim 2, i.e., a $Zr_{0.5}Ti_{0.5}Cr_{0.5}Mn_{0.5}Ni$ alloy. Further, the reference does not expressly teach that the hydrogen absorbing alloy is fluorinated, as recited in claim 1.

However, regarding the alloy of claim 2, a person of ordinary skill in the art may reasonably expect that a $Zr_{0.5}Ti_{0.5}Cr_{0.5}Mn_{0.5}Ni$ material and a $Zr_{0.6}Ti_{0.4}Cr_{0.5}Mn_{0.5}Ni$ material would have the same hydrogen-absorbing properties. A *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. See *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); MPEP §2144.05(I).

Furthermore, the patent of Sawa et al. is directed to a hydrogen storage alloy and a secondary battery using the same (see abstract). In column 4, line 21, the reference teaches that the alloy may be subjected to a fluorinating treatment.

Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the artisan would be motivated to apply the fluorinating treatment of Sawa et al. to the hydrogen storage

alloy of Lee et al. In column 4, line 17, Sawa et al. teach that "[t]he comminution and deterioration of the produced hydrogen-storage alloy by the absorption and release of hydrogen can be curbed by subjecting this alloy to [...] a fluorinating treatment." Accordingly, the artisan would be sufficiently motivated to apply the fluorinating treatment of Sawa et al. to the hydrogen storage alloy of Lee et al, thereby rendering the claimed subject matter obvious.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. in view of Sawa et al. as applied to claims 1-8 and 10 above, and further in view of Narayanan et al (U.S. Patent 6,485,851).

Lee et al. does not expressly teach that the oxygen source is an aqueous solution of a water-soluble oxidizing compound, as recited in claim 9.

Narayanan et al. is directed to a liquid fuel cell. In Example 1, the reference teaches that the oxygen source is an aqueous solution of hydrogen peroxide.

Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the artisan would be motivated by the disclosure of Narayanan et al. to use aqueous hydrogen peroxide as the oxygen source of Lee et al. In column 1, line 62, Narayanan et al. disclose the following:

> However, there still exists a need for an organic fuel cell capable of using an alternative oxygen source. In some fuel cell applications, air is absent or available in only limited quantities. For example, submarines and other underwater applications have little to no oxygen available for fuel consumption. Low noise signature, high volume and high

> specific energy density are also desirable for such underwater applications. High energy fuel cells based on pure compressed hydrogen and oxygen gas are disadvantageous for several reasons. The compressed tanks present safety concerns. The compressed tanks are also heavy and take up a lot of space which are impracticable or undesirable for some applications. Such cells also present other environmental and safety problems.

Thus, the artisan would be sufficiently motivated by this disclosure to use aqueous hydrogen peroxide as the oxygen source of Lee et al.

4. Claims 11-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. in view of Sawa et al. as applied to claims 1-8 and 10 above, and further in view of Wang et al (*J. Alloys and Compounds*, 1999).

Lee et al. do not expressly teach that the negative electrode comprises a substrate plate and a 50-300 micron-thick cladding layer containing the hydrogen-absorbing alloy, as recited in claims 11 and 12, or the thickness of the fluorinated alloy surface layer, as recited in claim 14.

However, regarding claim 14, the artisan would possess sufficient skill to manipulate the fluorine layer thickness on the alloy surface so as to fall within the claimed range of 0.01 to 1 micron. As set forth above, Sawa et al. teaches that the fluorinating treatment provides the alloy with resistance to degradation. The content and/or thickness of the fluorine layer may be routinely manipulated by a skilled artisan so as to affect the degree of such degradation resistance. Generally, the artisan would be motivated to use as thin a layer as possible so as to not adversely affect the other electrochemical characteristics of the alloy. It has been held that

the discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980). Thus, the range recited in claim 14 is not considered to distinguish over the references.

Additionally, the publication of Wang et al. is directed to an alkaline fuel cell employing a hydrogen absorbing alloy negative electrode. In Figure 2, the reference teaches that the negative electrode is comprised of a foamed nickel substrate, a catalyst (cladding) layer on the substrate, and a waterproof layer on top of the cladding layer. The cladding layer has a thickness of 250 microns and the waterproof layer has a thickness of 200 microns (see page 835, third full paragraph).

Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the artisan would be motivated to use the negative electrode structure of Wang et al. in the fuel cell of Lee et al. In section 3.5, Wang et al. teach that it is important that the anode has a long lifetime (550 h). Further, the substrate would improve the structural integrity of the electrode, and the waterproof layer would help to prevent flooding of the electrode. Thus, the artisan would be motivated to use the anode structure of Wang et al. in the fuel cell of Lee et al.

Response to Arguments

5. Applicant's arguments filed June 29, 2004 have been fully considered but they are not persuasive. Applicants assert that "in the Sawa reference, the fluorination treatment is suggested merely as one of various alternative or equivalent treatments." However, it is submitted that

even though the fluorination treatment is one of a number of alternatives, this would not negate the obviousness of applying such treatment to the material of Lee. In fact, it is believed that it would be obvious to apply any of these treatments to the material of Lee, because they are all disclosed as useful for curbing mechanical degradation. Applicants further state that such curbing of mechanical degradation "is not the object of the fluorination of the alloy material in the present invention." In response, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990).

Finally, Applicants assert that Sawa is directed to a secondary battery using a hydrogen storage alloy and not a liquid fuel cell as in the present invention. However, the Sawa reference is believed to be analogous to the claimed invention (and the Lee reference) because it is concerned with preventing deterioration of a hydrogen storage alloy as it absorbs and desorbs hydrogen. The present invention is also concerned with the absorption and desorption of hydrogen in an alloy (specification, paragraph [0026]). As such, reliance on the Sawa reference as the basis for rejection is believed to be proper.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Crepeau whose telephone number is (571) 272-1299. The examiner can normally be reached Monday-Friday from 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr, can be reached at (571) 272-1414. The phone number for the organization where this application or proceeding is assigned is (571) 272-1700. Documents may be faxed to the central fax server at (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jonathan Crepeau
Patent Examiner
Art Unit 1746
August 13, 2004